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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/765,456 | 01/26/2004 | John C. Kennell | SLU02-010 | 8365 |

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SAINT LOUIS UNIVERSITY
OFFICE OF RESEARCH ADMINISTRATION
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ST. LOUIS, MO 63104

EXAMINER

GUZO, DAVID

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,456

Applicant(s)

KENNELL, JOHN C.

Examiner

David Guzo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 6, 8-16, drawn to an isolated polynucleotide that comprises a sequence that encodes a reverse transcriptase (RT) polypeptide or fragment thereof wherein the RT is encoded by SEQ ID NO:3 or a sequence which encodes a RT polypeptide that comprises a sequence having 88% identity to SEQ ID NO:1 (encoded by SEQ ID NO:3), a vector comprising said sequence, cells containing said polynucleotide and a method of making a pFOXC-RT polypeptide, classified in class 536, subclass 23.1.
- II. Claims 1-3, 5, 7-16, drawn to an isolated polynucleotide that comprises a sequence that encodes a reverse transcriptase (RT) polypeptide or fragment thereof wherein the RT is encoded by SEQ ID NO:4 or a sequence which encodes a RT polypeptide that comprises a sequence having 88% identity to SEQ ID NO:2 (encoded by SEQ ID NO:4), a vector comprising said sequence, cells containing said polynucleotide and a method of making a pFOXC-RT polypeptide, classified in class 435, subclass 325.
- III. Claims 8-10, 15-16, drawn to an isolated polynucleotide SEQ ID NO:5, vectors containing said polynucleotide and a method of making a pFOXC-RT polypeptide, classified in class 435, subclass 69.1.

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- IV. Claims 8-10, 15-16, drawn to an isolated polynucleotide SEQ ID NO:6, vectors containing said polynucleotide and a method of making a pFOXC-RT polypeptide, classified in class 435, subclass 320.1.
- V. Claims 17-22, drawn to a method of making a complementary DNA molecule comprising combining a template polynucleotide molecule with a pFOXC-RT polypeptide having a sequence at least 88% identical to SEQ ID NO:1, classified in class 435, subclass 91.1.
- VI. Claims 17-22, drawn to a method of making a complementary DNA molecule comprising combining a template polynucleotide molecule with a pFOXC-RT polypeptide having a sequence at least 88% identical to SEQ ID NO:2, classified in class 435, subclass 91.5.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions each involve a distinct polynucleotide sequence (SEQ ID NO:3-6 and a method of using said sequence. Each polynucleotide sequence has a distinct nucleotide sequence and a search of one would not be co-extensive with a search of the others and hence would be burdensome. Each invention is capable of supporting a separate patent.

Inventions I-IV and V-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different

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designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions involve nucleic acid sequences and methods of use of said sequences to make polypeptides (Groups I-IV) while the methods of Groups V-VI involve use of RT polypeptides to make a complementary DNA copy of a template DNA. The methods of Groups V-VI can be practiced without the DNAs of Groups I-IV. Additionally, the method of Groups I-IV involves use of a DNA encoding a pFOXC-RT polypeptide to express said polypeptide while the methods of Groups V-VI involves the unrelated process of making a complementary DNA using a pFOXC-RT polypeptide in an in vitro technique. A search of one method would not be co-extensive with a search of the others and hence would be burdensome.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo, PhD, whose telephone number is (571) 272-0767. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, PhD, can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Guzo
April 1, 2006


DAVID GUZO
PRIMARY EXAMINER